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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,386	04/25/2001	Roger C. Williams	BIW-RIN6	6791

7590 02/20/2002
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EXAMINER

TA, THO DAC

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/842,386

Applicant(s)

WILLIAMS ET AL

Examiner

Tho D. Ta

Art Unit

2833

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Werner et al. (5,795,173).

Werner et al. discloses a receptacle connector 1 that includes an elastomeric lip 11, wherein a support ring 15 is embedded in the elastomeric lip 11 (see abstract).

In regard to the language “for use with railroad passenger cars”, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Werner et al.

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Werner et al. does not disclose a raised portion that extends around at least a portion of the circumference thereof.

It would have been obvious to modify Werner et al. invention by having the raised portion extending around at least a portion of the circumference thereof, since applicants have not disclosed that having the raised portion extends at this specific direction solves any stated problem or is for any particular purpose and it appears that the connecting device would perform equally well without the raised portion.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art (pages 1-3 of the specification).

Applicants' admitted prior art discloses generally all that is claimed except that the support ring is not embedded in the elastomeric lip so that the support ring will not be lost during operation or misplaced during assembly and thus provide a better electrical connection between two connectors.

It would have been obvious to one having ordinary skill in the art to integrally mold the support ring of Applicants' admitted prior art with the elastomeric lip so that the support ring will not be lost during operation or misplaced during assembly, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951).

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6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art (pages 1-3 of the specification) in view of Bissi et al. (4,607,854).

Applicants' admitted prior art discloses generally all that is claimed except that the support ring is not embedded in the elastomeric lip so that the support ring will not be lost during operation or misplaced during assembly and thus provide a better electrical connection between two connectors.

Bissi et al. discloses the support ring 7 is embedded in the elastomeric lip in order to provide a better seal area for the sealing lip 8 (column 3, lines 49-56) and further, the support ring will not be lost during operation or misplaced during assembly and thus provide a better electrical connection between two connectors.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Applicants' admitted prior art by embedding the support ring in the elastomeric lip as taught by Bissi et al. in order to provide a better seal area for the sealing lip.

Further, Applicants' admitted prior art does not disclose a raised portion that extends around at least a portion of the circumference thereof.

It would have been obvious to further modify Applicants' admitted prior art invention by having the raised portion extending around at least a portion of the circumference thereof, since applicants have not disclosed that having the raised portion extends at this specific direction solves any stated problem or is for any

particular purpose and it appears that the connecting device would perform equally well without the raised portion.

Oath/Declaration

7. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The claim for benefit of prior provisional patent application is not in the oath or declaration.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (703) 308-0800. The examiner can normally be reached on M-F (8:00-5:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.



tdt
February 13, 2002